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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re. Appln: Marco Scibora
Serial No.: 10/090,906
Filed: March 4, 2002
For: METHOD AND APPARATUS FOR DIGITALLY MARKING MEDIA CONTENT
Confirmation No.: 6517
Group Art Unit: 3625
Examiner: Mark A. Fadok
Attorney: Gerald E. Helget
Attorney Docket No.: 33046.35
Additional Fees: Charge to Deposit Account 023732

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL COVER LETTER

Dear Sir/Madam:

Enclosed for filing please find the following:

1. Appellant's Appeal Brief Under 37 C.F.R. § 41.37
2. A check in the amount of \$250.00
3. Postcard receipt.

Dated: 8 JAN 07

Respectfully submitted,

By Gerald E. Helget

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CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as First Class Mail, in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

By Gerald E. Helget

Date 8 JAN 07



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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APPELLANT'S APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Sir:

Appellant, by his attorney, submits one copy of this Appeal Brief, pursuant to 37 C.F.R. § 41.37 in further of the Appeal, the notice of which was filed with the United States Patent and Trademark Office on November 8, 2006, from the Final Rejection of claims 10 and 19-21 of the above-identified application, as set forth in the Final Office Action mailed on August 10, 2006. Appellant respectfully requests consideration and reversal of the Examiner's rejections of the pending claims.

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as First Class Mail, in an envelope addressed to Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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By: Gerald E. Helget

Date: 8 Jan 07

I. REAL PARTY IN INTEREST

The real party in interest is Advanced Communication Design, Inc.

II. RELATED APPEALS AND INTERFERENCES

Applicant is unaware of any related appeals or interferences that may have a bearing on the Board's decision in the present appeal.

III. STATUS OF CLAIMS

The present application was filed on March 4, 2002 with claims 1-29. A non-final Office Action was mailed December 20, 2005. A Final Office Action was mailed August 10, 2006. Claims 10, 19, 20 and 21 stand twice rejected, remain pending, and are the subject of the present Appeal.

IV. STATUS OF AMENDMENTS

No amendments have been made since the Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is (claim 10) an apparatus (10, page 5, Fig. 1) for allowing a consumer to digitally mark portions of media content and later retrieve the marked portions uniquely keyed to the consumer, comprising: storage (13, page 5, Fig. 1) for storing the media content; a server computer (12, page 5, Fig. 1) accessing the media content storage; a workstation (14, page 6, Fig.1) interacting with the server computer to allow the consumer to sample portions of the stored media content; a plurality of portable identification means (30, page 7, Fig.3) identifying the consumer, separate from the server and the workstation and the sampled portions, and including identifying indicia (32, page 7, Fig. 3) unique to each instance of the portable identification means, the portable identification means being presented to the workstation; and an array (42, page 7, Fig. 4) containing references to the identifying indicia received from the workstation and indicia (44, page 7, Fig. 4) keyed to selected instances of the sampled portions of the stored media content.

The present invention is (claim 20) an apparatus (10, page 5, Fig. 1) for allowing a consumer to digitally mark portions of media content and later retrieve the marked portions uniquely keyed to that consumer, comprising: storage (13, page 5, Fig. 1) for storing the media

content; a server computer (12, page 5, Fig. 1) accessing the media content storage; a workstation (14, page 6, Fig. 1) interacting with and connected to the server computer to allow the consumer to sample portions of the stored media content; a plurality of portable digital markers (38, page 7, Fig. 3) identifying the consumer, separate from the server and the workstation and the sampled portions, and including a bar code (34, page 7, Fig. 3) unique to each instance of the portable digital marker; and a shopper's reference database (page 3, 42) containing references to the unique bar codes received from the workstation and references to the sampled portions of the stored media content.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 10, 19, 20, and 21 were rejected obvious under 35 U.S.C. § 103(a) over Ritz in view of Kaplan.

VIII. ARGUMENT

A. Claims 10, 19, 20 and 21 are not unpatentable under 35 USC 103(a) as being obvious over Ritz in view of Kaplan.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.¹ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.²

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.³

¹ MPEP Sec. 2142

² Id.

³ Id. (emphasis supplied)

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

As to amended claim 10, Ritz does not disclose a plurality of portable identification means identifying the consumer, separate from the server, the workstation, and the sampled portions, the portable identification means being presented to the workstation; and an array containing references to the identifying indicia from the portable identification means received from the workstation and keyed to selected instances of the sampled portions of the stored media content.

In Ritz, a product such as a CD is presented to a workstation to obtain sampled portions. A code such as a UPC code located on a CD jewel box is submitted to a service provider that processes the code and returns to the user information indicative of audio tracks recorded on the recorded medium. The code does not identify the consumer, but instead is related to the product from which the sampled portions are obtained.

The Office Action states, in part:

Ritz teaches collecting identifying information from a user in order to track their usage habits, but does not specifically mention that the identifying information is received on a portable identification means. Kaplan teaches providing a barcode unique to the user to identify the user during a session (col. 5, lines 30-40). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Ritz identifying information received on a portable identification, because this would allow for quick identification of a user who is not using their own personal device and allowed access to the previews program.

Ritz does not indicate what means could be used for identifying a user. Thus, Ritz does not disclose a plurality of portable identification means identifying the consumer separate from the server and the workstation and the sampled portions. Ritz does indicate that:

In some embodiments, additional songs may be presented to the user based on selections the user has made in the past. For example, song source 570 (a song by a country and western artist) may be presented to the user based on the user's prior

selection of country and western audio tracks in an earlier session. [0027] (emphasis supplied)

This implies that the means to identify the user is not separate from the sampled portions. Rather, the identification means (whatever that may be) is “based on” the sampled portions (tracks) which the user has selected in an earlier session, and additional songs are only presented to the user if they are similar to earlier selected tracks. There is no disclosure in Ritz of presenting the actual songs previously selected in an earlier session. Thus, the user cannot “later retrieve the marked portions uniquely keyed to that consumer” (Preamble, claim 10).

Further, there is no motivation disclosed in Ritz to make such identifying information portable. As stated above, the motivation to combine references must be found in the prior art. If not found in the prior art, the Examiner must supply a cogent reason for making the combination, not based on the applicant’s disclosure. The only motivation disclosed by the Examiner is “quick identification of a user who is not using their own personal device and allowed access to the previews program.” Applicant does not understand this statement. Ritz does not require a user to use their own “personal device” (in fact, as already stated, Ritz has no disclosure of how the user is to be identified). Thus, there is no evidence that using a portable means of identification is any quicker than Ritz, because there is nothing to compare it to in Ritz. Thus, there is no motivation to make the asserted combination.

Claim 10 is thus allowable.

Claim 19 is dependent upon allowable claim 10 and is therefore also allowable.

Claim 20 is allowable for the same reasons stated above in regard to claim 1. In addition, the Examiner has not shown where the references disclose “a shopper’s reference database containing references unique to the unique bar codes received from the workstation and references to the sampled portions of the stored media content.”

Claim 21 is dependent upon allowable claim 20 and is therefore also allowable.

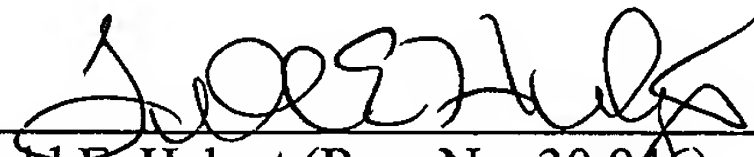
Finally, the Examiner has not applied the test of *Graham v. John Deere Co.*⁴ The MPEP requires the Examiner to do so.⁵ However, the Examiner has made no finding of the level of ordinary skill in the art.⁶

In view of the foregoing, Appellant asks the Board to overturn the Examiner's rejections and allow all claims.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 02-3732.

Respectfully submitted,

Dated: 8 Jan 07

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⁴ 383 U.S. 1 (1966)

⁵ MPEP § 2141

⁶ MPEP § 2141.03

CLAIMS APPENDIX

The claims on appeal:

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.